REMARKS

This paper is responsive to an Office Action mailed April 20, 2006. Prior to this response, claims 1, 4-14, and 17-31 were pending. After amending claims 1, 4, 8-12, 14, 17-18, 21-23, and 25, and canceling claims 28-31, claims 1, 4-14, and 17-27 remain pending.

The Office Action states that claims 1 and 14 have been rejected under 35 U.S.C. 102(b) as anticipated by Asai (US 5,663,805). Claims 1 and 14 have been amended to include subject matter previously found in claims 28 and 29, respectively. Since Asia does not allocate memory on the basis of document format, the Applicant respectfully requests that the rejection be withdrawn.

The Office Action states that claims 4-14, 17-21, and 24-31 have been rejected under 35 U.S.C. 103(a) as unpatentable with respect to Asai, in view of AuClair (5,659,670). The Office Action acknowledges that Asai does not allocate memory on the basis of document format. The Office Action asserts that AuClair's reuse of fonts in cache is associated with document type, and that it would have been obvious to combine the references, with the motivation being "to increase the system performance by allocation excess or unused memory (RAM) for document format, thereby overall efficiency of the printer is achieved. As such, the font cache management enabled by system 100 of the present invention can have an important effect on the efficiency of the printer." This rejection is traversed as follows.

An invention is unpatentable if the differences between it and the prior art would have been obvious at the time of the invention. As

stated in MPEP § 2143, there are three requirements to establish a *prima facie* case of obviousness.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck* 947 F.2d 488, 20 USPQ2d, 1438 (Fed. Cir. 1991).

In his Abstract and Summary (col. 2, ln. 19-48), AuClair describes a random access memory (RAM) for storing data in variably sized compartments, and a processor that generates compartment size allocation recommendations in response to source of the print jobs. At col. 8, beginning at ln. 6, AuClair describes a printer that is able to analyze and implement system 100 RAM functions related to printer operations. The various blocks in Fig. 1 show an analytical process that attempts to gauge future memory needs by reviewing the history of previous jobs, cross-referenced to input port (serial, parallel, and network). Decision block 130 permits a user to automatically change memory allocation, or display recommended allocations for user selection (col. 8, ln. 41-45). AuClair "reuses" fonts by storing fonts as bitmaps (col. 7, ln. 40-58). It should be understood that the storage of fonts in the bitmap form actually increases the amount of memory required. The advantage of storing the fonts in bitmap form is that processing time is saved. That is, the fonts need not be converted from the document language form, to the bitmap form ultimately needed to print a document.

Asai discloses a system that permits a user to divide memory between printer and "communication" functions (col. 4, ln. 25-34), where communication functions are associated with fax relaying operations (col. 3, ln. 63 through col. 4, ln. 3). Asai's system includes a RAM 9 for the storage of bitmap or image data (col. 3, ln. 3-10). The printer can be used to print a received bitmap image (col. 3, ln. 25) or as a copy machine (col. 4, ln. 31-34). Other than the memory allocation aspect, Asai describes a conventional fax machine. It should be understood that bitmap or image data is simply a "picture", and devoid of information about document formats and fonts. That is, Asai's fax machine does not convert a document from a printer language (e.g. PostScript) to a bitmap image.

With respect to the first *prima facie* requirement, the justification to combine references to improve performance or efficient, is not proof that an expert would be motivated to modify the Asai system in light of AuClair. Any two references could be combined for the purpose of an obviousness analysis with such a justification. Rather, the Office Action must supply some specific analysis of how an expert would have been motivated to modify a fax machine memory in light of a printer that reuses a font bitmap in cache memory. The Applicant respectfully submits that such an analysis would be impossible. A printer that converts a document from a document language to a bitmap, just prior to printing (AuClair; col. 7, ln. 34-40), cannot suggest modifications to a system that works solely with bitmap images (Asai).

Considered from the perspective of the second *prima facie* requirement, even if an expert were given the references as a foundation, there is no reasonable expectation that an expert would modify a simple fax machine to include any of the features mentioned by AuClair, since

these modification would complicate the fax machine by orders of magnitude. Likewise, there is no expectation that Asai's bitmap memory feature would suggest modifications to AuClair, since the point behind using document languages is to eliminate the communication and storage of memory-intensive bitmap images.

With respect to the third *prima facie* requirement, the Office Action acknowledges that Asai does not disclose the allocation of memory by document format. AuClair does not disclose this feature either. At col. 7, ln. 48-58, AuClair states that font cache management can have a positive effect on efficiency. However, the efficiency described by AuClair is related to decreases in processing time, not decreases in memory use. As is well known in the art, information in bitmap form is the most memory-intensive format. Alternately stated, document languages were invented to reduce the memory requirements associated with documents. For this reason, a printer only converts a document to bitmap form just prior to actual printing. For this reason, the Applicant respectfully submits that the AuClair disclosure actually points away from the claimed invention, since AuClair describes a feature that increases the need for memory space.

Further, Applicant's claim 1 and 14 explicitly recite allocating a percentage of RAM on the basis of document format. AuClair does not describe the ability of a user to select a percentage of RAM allocation. More explicitly, AuClair's reuse of fonts does not explicitly describe the allocation of RAM on the basis of document type. In fact, AuClair does not even describe the allocation of memory for font reuse.

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Therefore, the combination of Asai and AuClair does not explicitly teach the limitation of a user selecting RAM allocation for document format, as recited in claims 1, 14, and 26. Neither does AuClair suggest any modifications to Asai that would make these missing limitations obvious. Claims 4-13, dependent from claim 1, claims 17-21 and 24-25, dependent from claim 14, and claim 27, dependent from claim 26, enjoy the same distinctions from the cited prior art references and the Applicant requests that the rejection be removed.

The affidavit of James Owen is being submitted under 37 CFR 1.132, to support that Applicant's assertion that the combination of Asai with AuClair does not make the invention of claims 1, 14, and 26 obvious. Mr. Owen is a professional working in the field of printer driver software. In his affidavit Mr. Owens states that AuClair does not describe the partitioning of memory by document format. Further, Mr. Owen states that the combination of Asai and AuClair does not suggest modifications to Asia's fax machine that would make obvious the allocation of RAM on the basis of document type. Mr. Owen's conclusions are based upon the fact that AuClair's retention of font information as a bitmap in memory actually points away from the storage of information, and allocation of storage, by document format.
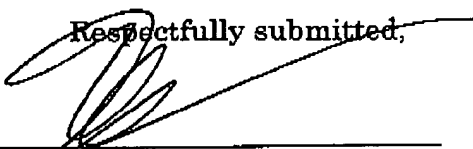
The Office Action states that claim 22 has been rejected under 35 U.S.C. 103(a) as unpatentable with respect to Asai, in view of well known art. The Office Action states that Asai describes an MFP with print, scan, and fax functions, and that it would have been obvious to reboot the system of Asai. This rejection is traversed as follows.

Asai does not describe an MFP, as an MFP is generally understood to be a device capable of receiving documents in a document

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language. As presented above, Asai is capable of working only with bitmaps. However, it is not necessary to even address this issue. As acknowledged in the Office Action, Asai does not allocate memory on the basis of document format. Therefore, even is Asai is combined with well know art, the combination does not disclose the allocation of memory on the basis of document format, as recited in claim 14. Claim 22, dependent from claim 14, enjoys the same distinctions from Asai, and the Applicant requests that the rejection be withdrawn.

The Office Action states that claim 23 has been rejected under 35 U.S.C. 103(a) as unpatentable with respect to Asai, in view of Bitar et al. ("Bitar"; US 6,353,844). Asai does not allocate memory on the basis of document format. Even if Bitar is combined with Asai, the combination does not describe the allocation of memory on the basis of document format, as recited in claim 14. Claim 23, dependent from claim 14, enjoys the same distinctions from Asai, and the Applicant requests that the rejection be withdrawn.

It is believed that the application is in condition for allowance and reconsideration is earnestly solicited.

Respectfully submitted,

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